REMARKS/ARGUMENTS

In the Office Action mailed November 13, 2008 (hereinafter, "Office Action"), claims 1, 3-7, 9-11, 13-16, 18-20, 22-26 and 28 stand rejected under 35 U.S.C. § 103. Claims 1, 11 and 20 have been amended.

Applicants respectfully respond to the Office Action.

I.   Claims 1, 3-7, 9-11, 13-16, 18-20, 22-26 and 28 Rejected Under 35 U.S.C. § 103(a)

Claims 1, 3-7, 9-11, 13-16, 18-20, 22-26 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0042884 to Wu et al (hereinafter, "Wu") in view of U.S. Patent Application Publication No. 2003/0140009 to Namba et al. (hereinafter, "Namba") in further view of U.S. Patent Application Publication No. 2002/0046350 to Lordemann et al. (hereinafter "Lordemann"). This rejection is respectfully traversed.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims at issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 2007 U.S. LEXIS 4745, at **4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a claim." In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)). Moreover, the analysis in support of an obviousness rejection "should be made explicit." KSR, 2007 U.S. LEXIS 4745, at **37. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

Claim 1, as amended, provides:

1.   A method for securing an imaging job, the method comprising:

performing an access control function relating to a document;

performing an auditing function relating to the document, including extracting
        reduced content information from the document and storing the reduced
        content information in secured storage as at least part of an audit trail
        generated by the auditing function;

generating an imaging job from the document;

encrypting content of the imaging job and not encrypting non-content such that a
        downstream non-content dependent process will still properly process the
        imaging job;

decrypting the encrypted content by a recipient;

encoding into imaging output non-destructible information; and

erasing residual data <u>containing any content of</u> ~~that relates to~~ the imaging job
        <u>both on a client device and an imaging device, the content of the imaging
        job comprising instructions configured to produce visible information on
        the imaging output</u>.

(Changes shown.) Support for this amendment is found, for example, at paragraphs [76], [86], and [95]-[98] and at Figure 8 of the pending application.

Amended claim 1 of the pending application thus requires: "erasing residual data containing any content of the imaging job both on a client device and an imaging device, the content of the imaging job comprising instructions configured to produce visible information on the imaging output." The Office Action cites to page 8, paragraph [0191] of Wu to teach this subject matter (prior to the current amendments). (Office Action at p. 4.) This paragraph of Wu states:

> An attacker has virtually unlimited time to attack the client software, but attacking hardware is far more difficult. Therefore, the sensitive part [of the client software] can be obtained from the hardware during printing, and erased from memory immediately the printing process is completed. A very skilled attacker may be able to successfully attack the client software and print unlimited copies of document, but the copies will be noticeably invalid because there is no optical watermark for authentication.

While this paragraph of Wu discloses that a "sensitive part can be . . . erased," this phrase refers to "client software" that performs functions (such as "watermark generating functions" and "access control") rather than content[1] of an imaging job, as required by claim 1. (Wu at paragraphs [0184]-[0191].) This point is supported by the fact that Wu states that "the sensitive

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[1] "Content" of an imaging job is disclosed in contrast to "non-content" of the imaging job, which does not produce visible information on the imaging output, such as job or page control instructions. (Pending application at paragraph [86].)

part [of the client software] can also be <u>installed</u> in the client's machine together with the basic part of the client software." (Wu at paragraph [0189] (emphasis added).) The "client software" of Wu thus clearly refers to installable software rather than document content "comprising instructions configured to produce visible information on the imaging output," as required by claim 1. Further, Wu does not disclose erasing "residual data containing any content of the imaging job <u>both on a client device and an imaging device</u>," as is also required by claim 1. (Emphasis added.)

In view of the foregoing, Applicants respectfully submit that claim 1 is patentably distinct from the cited references. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn because Wu, alone or in combination with Namba and Lordemann, does not teach or suggest all of the subject matter of claim 1.

Claims 3-7 and 9-10 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 3-7 and 9-10 be withdrawn.
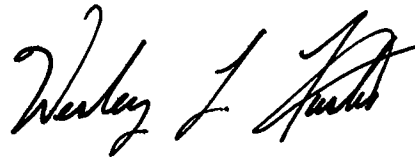
Claims 11 and 20, as amended, include subject matter similar to the subject matter of claim 1. Accordingly, Applicants respectfully request that the rejection of claims 11 and 20 be withdrawn for at least the same reasons as those presented above in connection with claim 1.

Claims 13-16 and 18-19 depend either directly or indirectly from claim 11. Claims 22-26 and 28 depend either directly or indirectly from claim 20. Accordingly, Applicants respectfully request that the rejection of claims 13-16, 18-19, 22-26 and 28 be withdrawn.

II.   Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

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